

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 1, 12-13, 46, 53, 58, 190-192 and 194-222 are pending after entry of the amendments set forth herein.

Claims 203-218 are currently withdrawn from examination.

Claims 1, 12, 13, 46, 53, 58, 190-192, 194-202, 219 and 220 were examined.

Claims 1, 12, 13, 46, 53, 58, 190-192, 194-199, 202, 219 and 220 were rejected.

Claims 200 and 201 were objected to, but indicated to contain allowable subject matter.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Claim Rejected Under 35 U.S.C. Section 102(e) (Vierra et al.)

Claims 1, 46, 58, 190-192, 194-196, 198 and 202 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Vierra et al., U.S. Patent No. 5,749,892. The Examiner asserted that Vierra et al. discloses a device that includes a contact member (15,17) shapeable to engage the surface of a beating heart and a means for introducing positive or negative fluid pressure to the contact member (col. 8, lines 35-37).

Applicants respectfully traverse. It is respectfully submitted that column 8, lines 35-37 refer to an irrigation lumen 75 that can be coupled to a vacuum source to suction fluids from the surgical site out of the patient. It is respectfully submitted that such performance of irrigation does not function to fix a shape of either of the feet 15, 17 of Vierra et al.

The Examiner further asserted that the contact member of Vierra et al. is hollow and made of malleable material. The Examiner referred to column 9, line 11 of Vierra et al. as support for these assertions.

Applicants respectfully traverse. Column 9, line 11 of Vierra et al. describes the foot 11a shown

in Fig. 4, not the feet 15,17 that the Examiner has interpreted as the “contact member”. Further, column 9, line 11 does not disclose a malleable material, contrary to the Examiner’s assertion. Rather, column 9, line 11 discloses that the foot 11a is made of a flexible material such as rubber. Thus, neither the foot 11a nor the annular ring 100 provide any shape memory ability and cannot retain a shape that they are shaped into, since they are not made of malleable materials.

The Examiner further asserted that Vierra et al. discloses a malleable member extending along at least a portion of a contact member comprising a flexible tube. The Examiner did not cite any specific location in the Vierra et al. disclosure that is interpreted as making such disclosure. Further, Applicants were unable to find such disclosure anywhere in the Vierra et al. reference.

Claim 1 has been amended to further clarify that the introduction of said positive or negative fluid pressure is capable of fixing said contact member and contact surface at any of a plurality of different shapes that said contact member and contact surface are capable of being shaped into prior to said introducing a positive or negative fluid pressure. Claim 190 has been amended above to further clarify that said shape of said contact member is variable, depending upon a shape of the surface of the heart that said contact member is conformed to. Support for these amendments can be found, for example, at pages 30-31 of the specification and throughout the specification and drawings.

In view of the above amendment and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 46, 58, 190-192, 194-196, 198 and 202 under 35 U.S.C. Section 102(e) as being anticipated by Vierra et al., U.S. Patent No. 5,749,892, as being inappropriate.

Claim Rejected Under 35 U.S.C. Section 103(a) (Vierra et al. in view of Koros et al.)

Claims 12 and 13 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Koros et al., U.S. Patent No. 6,113,534.

It is respectfully submitted that the Examiner has not set forth a prima facie case of obviousness. Koros et al. has an effective filing date of March 19, 2008. The effective filing date of the present claims goes back at least as far as January 27, 1997. Accordingly, it is respectfully submitted that Koros et al. is not prior art against the present claims.

In view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 12 and 13 under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Koros et al., U.S. Patent No. 6,113,534, as failing to set forth a

prima facie case of obviousness.

Claim Rejected Under 35 U.S.C. Section 103(a) (Vierra et al. in view of Boyd et al.)

Claims 53, 197, 199, 219 and 220 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Boyd et al., U.S. Patent Application Publication No. 2002/0069884.

It is respectfully submitted that the Examiner has not set forth a prima facie case of obviousness. The paragraphs [0116], [0119], [0112] and [0111] of Boyd et al. are not disclosed in either of the parent applications (08/281,891 and 08/023,778). Accordingly, the effective filing date of Boyd et al., as applied, is October 19, 2001. The effective filing date of the present claims goes back at least as far as January 27, 1997. Accordingly, it is respectfully submitted that Boyd et al. is not prior art against the present claims.

In view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 53, 197, 199, 219 and 220 under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Boyd et al., U.S. Patent Application Publication No. 2002/0069884, as failing to set forth a prima facie case of obviousness.

New Claims

New claims 221-222 have been submitted above. Support for claim 221 can be found, for example, in claim 1 (prior to the above amendment of claim 1) and claim 12. Support for claim 222 can be found, for example, at claim 13. Support for claim 222 can be found, for example in claim 13. The Examiner is respectfully requested to indicate the allowance of claims 221-222 in the next Official Action.

Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-005CON6.

Respectfully submitted,
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